

REMARKS

INFORMATION DISCLOSURE STATEMENT

The Examiner has noted that references 5 and 105 contained within Applicants Information Disclosure Statement have not been considered because they have not been cited appropriately.

In response, Applicants have checked their records and note that reference 5 should be U.S. Pat. No. 6,579,949 and reference 105 should be U.S. Pat. No. 6,313,232.

CLAIM OBJECTIONS

The Examiner has objected to claims 2 and 8 due to typographical errors. These errors have been corrected.

REJECTIONS UNDER 35 U.S.C. § 112

The Examiner has rejected claims 3, 9-11,, 13, and 15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. According to the Examiner, the specification does not include a description of a "green tire component," and therefore the intended scope of claim 3, and claims 9-11, 13, and 15 by dependency, are indefinite.

Claim 3 has been amended by removing the term "green" and including therefore "uncured." Applicants believe that claim 3 is now consistent with the description on page 16 of the written description.

REJECTION FOR OBVIOUSNESS-TYPE DOUBLE PATENTING

The Examiner has rejected claims 1, 3, 6, 7, 9, and 15 on the ground of non-statutory obviousness-double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 7,153,919.

In an effort to expedite prosecution at this time, the Applicants submit herewith a terminal disclaimer under 37 C.F.R. § 1.321(b) and (c). Because the Applicant maintains that the subject claims are not identical to those of U.S. Patent No. 7,153,919, this terminal disclaimer overcomes the subject rejection. See *In re Schneller*, 158 U.S.P.Q. 210 (C.C.P.A. 1968).

The Examiner has provisionally rejected claims 1 and 7 on the ground of non-

statutory obviousness-double patenting as being unpatentable over claims 1 and 11-13 of co-pending Application No. 11/607,690.

To the extent that the Applicants are filing a terminal disclaimer relating to U.S. Patent No. 7,153,919, and since Application No. 11/607,690 is a Continuation of the same, the Applicants assert that the public interest served by the terminal disclaimer does not require an additional terminal disclaimer relating to the cited application. The same may also be said about Application No. 11/900,664 and Application No. 11/900,686, which likewise claim the benefit of the present application.

The Examiner has provisionally rejected claims 1, 4, 6, and 7 on the ground of non-statutory obviousness-double patenting as being unpatentable over claims 1, 15, 16, and 18 of co-pending Application No. 11/331,663. The Applicants respectfully disagree with the Examiner's finding, and note that the policy supporting nonstatutory obviousness-type double patenting is not served in this case. The patentee is not seeking a timewise extension of the cited claims if they may issue in a patent.

Claim 1 of the '663 application recites a tire tread comprising, among other things, a filler comprising oxidized carbon black. The use of oxidized carbon black with the recited functionalized polymer is a patentable advancement over the prior art. In order to infringe claim 1 (as well as claims 15, 16, and 18) of the '663 application, an infringing product must include the recited carbon black. In contradistinction, the claims rejected by the Examiner do not recite oxidized carbon black. The Applicants fail to see how and the Examiner has not established that the claims associated with this application, should they issue, would violate the policy behind the rejection, because the present application would not extend the monopoly secured under the claims in the '663 application (should those claims issue). Again, the '663 claims require oxidized carbon black, but the present claims do not. This is especially true in view of the fact that the prior art does not teach or suggest the use of the particular functionalized polymers in combination with oxidized carbon black. Reconsideration is earnestly solicited.

ALLOWABLE SUBJECT MATTER

Applicants note that the Examiner has found claims 2 and 8, and claims 12 and 14 as dependent thereon, to include allowable subject matter inasmuch as they would be allowable upon correction of the cited informalities. Also, claim 5 has been objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

independent form and upon resolution of the double patenting rejection.

CONCLUSION

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully requests the Examiner to reconsider the rejections provided in the last Office Action. A formal Notice of Allowance of claims 1-15 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

No new claims have been added and therefore no additional fees are believed due at this time. The fee associated with the terminal disclaimer, per 37 C.F.R. 1.20(d), of \$130 is included. In the event that a fee required for the filing of this document is missing or insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,



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